

## 5. REMARKS

### 1. Claim Objections

The informalities of Claims 1-24 have been corrected and the Claims are numbered in English standard numbers (i.e. 1, 2....).

The informalities of Claims 2-9 have been corrected, and amended claims now start with the word "The".

### 2. Claim Rejections

#### 2.1. Rejection under 35 USC Section 112

Claims 15-17 have been rejected under 35 U.S.C. 112, first paragraph, because they allegedly contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention, and that the language cited in the claims does not appear in the specification.

With respect to the above rejection, I would like to draw to the Examiner's attention the following points:

- a) Claims 15 to 17 have been amended to make them clearer. The amended claims 15 to 17 are enabled in the specification. No new matter is added.

- b) The third paragraph of the description of the invention indicates: “One embodiment of the device is the emission of a single message. There may be other embodiments that *will customize the emitted messages to certain indicators of the printed matter; for example, opening of each chapter of a book may elicit a different message or music.* (See page 4, paragraph 2 of the description of the invention).
- c) The language of amended Claim 15 is described in said paragraph of the specification because opening of a book (indicated in the specification) is an example of opening a part of the printed matter (and Claim 15 refers to “opening of different parts of the printed matter.”) Therefore, Claim 15 is described by an example in the specification.
- d) The language of amended Claim 16 is also described in said paragraph of the specification because pressing an area of the printed matter, as referred to in the claim, may be the result of trying to open a book chapter (printed matter). Therefore, the language of Claim 16 is described in the referred example in the specification.
- e) The language of amended Claim 17 is also exemplified in the specification. Opening of a book (printed matter) is an example of physical contact with the printed matter.

For all of the above reasons, Claims 15-17 have been described in the specification with an example (opening of a chapter in a book) that is sufficiently clear to enable someone skilled in the art to make and/or use the invention. Thus, the provisions in 35 U.S.C. 112, first paragraph have been observed.

In addition, I would like to emphasize that “While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.” Genentech v. Novo Nordisk, 108 F. 3d 1361, 42 USPQ 2d 1001 (Fed. Cir), at 1005. Therefore, should the Examiner still consider that Claims 15-17 have not been described in the specification, the claim need not to have

been completely exemplified in the specification and reasonable detail has been provided therein to enable a person skilled in the art to make or use the invention.

## 2.2 Other Claim Rejections under 35 USC Section 112

In addition, Claims 1-24 have been rejected for being considered indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended, and the changes are indicated in the section of amendments below.

## 2.3 Claim Rejections under 35 USC Section 102

Claims 1-24 have been rejected for being considered to be clearly anticipated by Leung (5,569,868). Following, I will clarify that Leung does not anticipate the audio device incorporated into printed matter invention subject of this application.

First, the two inventions are very different. The Leung invention is claimed for a sound generating book, while the present application is claimed for an audio device incorporated into printed matter, which may be, a multipage document with text or designs, therefore, applicable not only to books, but also to magazines, to cards, and to any other printed matter (multipage document containing text or designs).

The present invention contains only one microchip while that of Leung comprises several transmitters and receivers positioned at various sections of a book.

An unique feature of this invention is that it contains a memory device that allows the reader to customize her own message. The user can also make the electrical micro device to create a message to remind her where she last time stopped reading or reviewing. Therefore the present invention is much more flexible giving several options for the user.

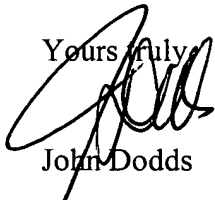
Also a unique feature of this invention is that the user can decide when to use the electrical micro device. The electrical micro device can be positioned e.g. in the spine of a

book and the user may by pushing a switching button choose to use the electrical device reproducing the sounds or decide not to use it this time. More over, the device can be sandwiched between pages of a book. Leung has not described such an embodiment.

#### CONCLUSION

Accordingly, each of the objections and rejections has been addressed and it is respectfully submitted that the application is in condition of allowance.

Yours truly,



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